<div align="center">REMARKS</div>

The present application and its claims are directed to a system and method for collection and conversion of document sets and related metadata to a plurality of document/metadata subsets.

<div align="center">PRIOR ART REJECTIONS</div>

In response to the Examiner's rejection of Claims 1-3, 13-15 and 25-27 under 35 U.S.C. 103 as being unpatentable over US Published Patent Application No. 2004/0205462 to Levine (hereafter "Levine") in view of US Patent Application Publication No. 2004/0205462 to Ghani ("Ghani") and further in view of US Patent No. 5,911,776 to Guck ("Guck"), the rejection of claims 3-7, 15-19 and 27-31 as being unpatentable over Levine, in view of Ghani and Guck and further in view of US Published Patent Application No. 2002/0035697 to McCurdy et al. (hereafter "McCurdy"), the rejection of claims 8-10, 20-22 and 32-34 as being unpatentable over Levine, Ghani and Guck and further in view of US Published Patent Application No. 2003/0163784 to Daniel et al. (hereafter "Daniel") and the rejection of claims 11-12, 23-24 and 35-36 as being unpatentable over Levine, Ghani and Guck and further in view of US Published Patent Application No. 2004/0201633 to Barsness (hereafter "Barsness"), Applicant traverses the rejections because the examiner has not established a prima facie case of obviousness (for the reasons set forth below) and therefore the rejections above are improper and must be withdrawn.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, and the prior art reference must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Also, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

<u>Claims 1, 13 and 25</u>

These claims are improperly rejected as being unpatentable over Levine because the examiner has not established a prima facie case of obviousness. For this particular rejection, the examiner cannot establish that the combination of prior art (Levine, Ghani and Guck), alone or in combination, teach or suggest all of the claim limitations. For these reasons, the rejection of

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claims 1, 13 and 25 should be withdrawn. In addition, the claims (claims 2-12, 14-24 and 26-36) that depend from these independent claims are allowable over the prior art for at least the same reason as the independent claims.

> ### Levine, Ghani and Guck Do Not Teach or Suggest Each Claim Limitation

Levine, Ghani or Guck do not teach each of the claims limitations (*See pages 2-4 of the Final Office action*) nor does Levine, Ghani or Guck suggest all of the claims limitations. In particular, the claims recite "a conversion module that generates two or more editions of a work having different formats, the two or more editions of the work being generated based on the intermediate format file and the work metadata" which is not taught or suggested by Levine, Ghani or Guck.

In the final office action, the examiner admits that both Levine and Ghani fail to disclose this element. (*See Final Office Action at pg. 3-4*). The examiner argues that, "However, Guck discloses a system that produces multiple outputs in what are called Shadow Files (see Fig. 2A)." *See Final Office action at pg. 4.* Guck discloses that, "As an example, let it be assumed that the User-author generates a document with content using the common universal format designated as RTF." (*Guck at col. 6, lines 65-67.*) and "Now if the user wishes to send this document onto a FAX machine, it would be necessary to convert the RTF format into another format such as TIFF (Tag Information File Format) as indicated in Figure 2A." (*Guck at col. 7, lines 2-11.*)

Thus, the Guck system allows the user to create the shadow files in various formats. (*Guck at col. 7, lines 21- 53.*) However, Guck does not disclose "a conversion module that generates two or more editions of a work having different formats, the <u>two or more editions of the work being generated based on the intermediate format file and the work metadata</u>" since Guck does not have an intermediate format file (the RTF file is the original user generated file). In addition, Guck does not generate the editions (the Shadow files) based on work metadata as claimed as the Shadow files are simple conversions of the Shadow files into different formats. Thus, Levine, Ghani and Guck do not teach or suggest each element of claims 1, 13 and 25 and therefore the rejections of claims 1, 13 and 25 (as well as the dependent claims) cannot be maintained since the examiner has not established a prima facie case of obviousness of these claims for the reasons set forth above.

CONCLUSION

In view of the above, it is respectfully submitted that Claims 1-36 are allowable over the prior art cited by the Examiner and early allowance of these claims and the application is respectfully requested.

The Examiner is invited to call Applicant's attorney at the number below in order to speed the prosecution of this application.

The Commissioner is authorized to charge any deficiencies in fees and credit any overpayment of fees to Deposit Account No. 07-1896.

Respectfully submitted,

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